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10/807,346	03/24/2004	Daisetsu Tohyama	018656-683	5384
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EXAMINER				
PARK, CHAN S				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

# Office Action Summary

**Application No.**

10/807,346

**Applicant(s)**

TOHYAMA, DAISETSU

**Examiner**

CHAN S. PARK

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 5, 6 and 8-13 is/are rejected.  
7) ☐ Claim(s) 3, 4 and 7 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/00)  
Paper No(s)/Mail Date 3/24/04, 2/1/06 & 11/29/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims are objected to because of the following informalities:

Claim 1, line 2, "such data" should be -- said image data --;

Claim 1, line 9, "the recipients" should be -- the specified recipients --;

Claim 1, line 11, "image data" should be -- said image data --;

Claim 2, line 2, "such data" should be -- said image data --;

Claim 2, line 11, "units of image data" should be -- units of said image data --;

Claim 2, line 12, "units of image data" should be -- units of said image data --;

Claim 2, line 13, "such data" should be -- said image data --;

Claim 3, line 2, "such data" should be -- said image data --;

Claim 3, line 9, "units of image data" should be -- units of said image data --;

Claim 6, lines 9-10, "units of image data" should be -- units of said image data --;

Claim 6, line 11, "units of image data" should be -- units of said image data --;

Claim 6, line 12, "such data" should be -- said image data --;

Claim 7, line 2, "such image" should be -- said image --;

Claim 7, line 7, "units of image data" should be -- units of said image data --;

Claim 7, line 9, "estimating for each group" should be -- estimating by a processing burden estimation unit, for each group --;

Claim 10, lines 8-9, "units of image data" should be -- units of said image data --;

Claim 10, line 10, "units of image data" should be -- units of said image data --;

Claim 10, line 11, "such data" should be -- said image data --;

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Claim 12, line 2, "such image" should be -- said image --;

Claim 12, line 8, "units of image data" should be -- units of said image data --;

and

Claim 12, line 10, "estimating for each group" should be -- estimating, by a processing burden estimation unit, for each group --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-13 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP

2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

**Claims 8-13**, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program

simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo U.S. Patent No. 6,801,340 in view of Motoyama U.S. Patent No. 6,456,402.

**With respect to claim 1**, Endo discloses an image transmission apparatus (document transmission apparatus in figs. 2 & 3) that sends to specified recipients image data awaiting transmission after subjecting said image data to image processing consisting of one or more operations (transmitting the converted image data to the destinations specified in col. 6, lines 60-67), said image transmission apparatus comprising:

multiple task processors that are respectively responsible for executing one or more of the image processing operations (format converter 308 having plural format converting units in fig. 3);

a designating unit that designates the image processing operation(s) to be performed (designating the format to be used in the image data in col. 6, lines 18-32);

a controller that, where multiple recipients are specified with regard to the image data and different image processing operations are specified for the different recipients, controls each task processor such that the different operations are executed for different recipients (controller for converting the image data based on the different format designated in col. 6, lines 46-59); and

a transmission unit that transmits to the specified recipients the image data that has undergone all of the image processing operations (transmitting the converted image data to the destinations specified in col. 6, lines 60-67).

Endo, however, does not explicitly disclose the apparatus wherein the multiple task processors executing identical/common image processing operations for all specified recipients before performing the conversion process.

Motoyama discloses an image transmission apparatus for executing specified image merging operation of the registered image data and scanned image data (col. 4, lines 18-33 & col. 7, lines 4-13) and transmitting the merged/image processed document/image to user selectable destinations (col. 5, lines 1-6).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image transmission apparatus of Endo to incorporate the merging processor and execute the merging operation before the format conversion (S909 of Endo) as taught by Motoyama.

The suggestion/motivation for doing so would have been to provide an image transmission apparatus that merges to image data and broadcasts the merged document/image to a plurality of recipients that may required different format conversions (abstract of Endo).

Therefore, it would have been obvious to combine Endo with Motoyama to obtain the invention as specified in claim 1.

**With respect to claims 5, 8 and 9**, arguments analogous to those presented for claim 1, are applicable. Also, refer to col. 16, lines 20-25 of Endo for the computer-readable medium limitation.

**With respect to claim 2**, Endo discloses an image transmission apparatus (document transmission apparatus in figs. 2 & 3) that sends to specified recipients image data awaiting transmission after subjecting said image data to image processing consisting of one or more operations (transmitting the converted image data to the destinations specified in col. 6, lines 60-67), said image transmission apparatus comprising:

an image data storage unit that stores the image data for which transmission has been requested (document storing unit RAM 203 in col. 3, lines 36-44);

multiple task processors that are respectively responsible for executing one or more of the image processing operations (format converter 308 having plural format converting units in fig. 3);

a designating unit that designates the image processing operation(s) to be performed to the image data stored in the image data storage unit (designating the format to be used in the image data in col. 6, lines 18-32);

a controller that controls each task processor such that the operations for each unit of said image data are performed (controller for converting the image data based on the different format designated in col. 6, lines 46-59); and

a transmission unit that transmits to the specified recipients the image data that has undergone all of the image processing operations (transmitting the converted image data to the destinations specified in col. 6, lines 60-67).

Endo, however, does not explicitly disclose the apparatus wherein the multiple task processors executing identical image processing operations for all specified recipients before performing the conversion process.

Motoyama discloses an image transmission apparatus for executing specified image merging operation of the registered image data and scanned image data (col. 4, lines 18-33 & col. 7, lines 4-13) and transmitting the merged/image processed document/image to user selectable destinations (col. 5, lines 1-6).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image transmission apparatus of Endo to incorporate the merging processor and execute the merging operation before the format conversion (S909 of Endo) as taught by Motoyama.

The suggestion/motivation for doing so would have been to provide an image transmission apparatus that merges to image data and broadcasts the merged



document/image to a plurality of recipients that may required different format conversions (abstract of Endo).

Therefore, it would have been obvious to combine Endo with Motoyama to obtain the invention as specified in claim 2.

**With respect to claims 6, 10 and 11**, arguments analogous to those presented for claim 2, are applicable. Also, refer to col. 16, lines 20-25 of Endo for the computer-readable medium limitation.

***Allowable Subject Matter***

4. **Claims 3, 4 and 7** would be allowable if rewritten or amended to overcome the Claim Objection, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Independent claims 3 and 7 define an image transmission apparatus for sending image data to multiple specified recipients wherein the image data is divided into groups by recipients and each group requires different image processing. The apparatus further estimates the processing burden of executing the image processing of the grouped image data and controls the processor such that the image data undergoes the specified image processing in order from the group having the smallest estimated processing burden to the group having the largest estimated processing burden as depicted in fig. 10 and paragraph 156 of the Specification (US 2005/0030579). The claims distinguish over the prior art in that the image data undergoes the specified

image processing in order from the group having the smallest estimated processing burden to the group having the largest estimated processing burden.

The most relevant prior art Tone et al. (US 5,715,070) teaches an image processing apparatus that changes the sequence of image processing. However, Tone does not teach the processing burden estimation unit/step and controlling unit/step for processing the image data in order from the group having the smallest estimated processing burden as estimated by the processing burden estimation unit/step to the group having the largest estimated processing burden.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/  
Examiner, Art Unit 2625

April 11, 2008